

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1 and 4-22 are now in the application. Claims 1, 10, and 11 have been amended. Claims 16-22 have been added.

Claims 10 and 11 have been amended in response to the rejection thereof under 35 U.S.C. § 112. The conductor track connection (formed with the base section 14, the resilient latching section 16, and the resilient locking section 18) is indeed a flat structure. The rejection of claims 10 and 11 is believed to be moot.

The amended claim 1 and the added claim 16 are more specifically drawn to add two further features, namely:

- two base contact projections 20; and
- a locking contact projection 42.

Support is found for the added features in Figs. 1 and 2 and on page 8, second paragraph, of the specification as originally filed.

The added claims 17-22 are fully supported in the original dependent claims.

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

Should the Examiner have any questions or comments with regard to the amendment, counsel would appreciate a telephone call, during which the matter may be discussed.

Before delving into the specifics of the art rejections, we note, in general terms, that the invention of the instant application and the structure disclosed by Glaesel have several common functional features. In Glaesel, the connection between the connecting terminal and the conductor bar is provided via a locking section and a latching section. This is similar to the instant application. (In contrast, the attachment of the connecting terminal on the conductor bar in Köllmann is effected via mirror-symmetrical elements.) Also, the conductor track connection in Glaesel is embodied in one piece, again, similar to the instant application. (In contrast, the connection in Köllmann consists of two materials, namely, insulating material of the insulator stops 5, and conductive material of the contact clamps 6.)

35 U.S.C. § 102 - Glaesel

We now turn to the art rejection, in which claims 1, 4-8, 11, 12, and 15 have been rejected as being anticipated by Glaesel under 35 U.S.C. § 102.

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Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). W.L. Gore and Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303 (Fed. Cir. 1983). In other words, a claim is anticipated if a single reference, either expressly or inherently, discloses every limitation of the claim at issue. In re Schreiber, 128 F.3d 1473 (Fed. Cir. 1997).

Turning now specifically to the claimed invention, Glaesel's patent discloses a device that may appear similar to that of the claimed invention. Glaesel, however, deals with a mechanical connecting terminal while the instant application pertains to an electric connecting terminal. That is, the conductor track connection in Glaesel consists of an insulating material, whereas the conductor track connection according to the instant application consists of metal.

As explained by Glaesel:

FIG. 1 shows a lower part of a slab-shaped body 10 of electrically insulating material

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

Glaesel, col. 2, lines 19-20.

It is clear that Glaesel cannot anticipate either claim 1 or claim 16. In addition, Glaesel also does not render the claimed invention obvious. In order for the art to prompt one of skill in the art towards the claimed invention, that person would have to be prompted to modify the Glaesel connecting terminal towards an electric connecting terminal. It is clear that such a suggestion is not found in the art.

Returning once more to the structural details, a further difference between Glaesel and the invention pertains to the stability of the connection of the connecting terminal with the conductor bar: as can be seen from Figs. 3 and 4 of Glaesel, the base section does not come to rest on the conductor bar, which is why the connecting terminal seems to abut against the conductor bar in a relatively unstable manner, i.e. exclusively via the locking section and the latching section on the opposite ends of the edge flanges.

Initially, the invention overcomes this disadvantage in that

the base section has first and second base contact projections (20) for abutting against the first and second edge flange; and

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

the locking section has a locking contact projection
(42).

With the projections 20 and 42, the connecting terminal of the instant application can be clamped between the locking contact projection 42 and a base contact projection 20 as well as the latching projection 48 and the second base contact projection 20, which results in a more stable and safely contacting connection between the connecting terminal and the conductive bar, because the connecting terminal along a line through the projections 20 is not only connected with the conductor bar to the opposite ends of the edge flanges, but also between these ends.

Glaesel does not contain any information towards such an attachment. Instead, Glaesel teaches away from such an attachment. Figs. 3 and 4 of the reference pertain to the embodiment for U-shaped conductor bars, show that the base section does not have any contact to the conductor bar. The contacts of the base sections with the conductor bar are exactly what leads to a more stable connection of the connecting terminal with the conductor bar.

Claims 1 and 16 are neither anticipated by nor obvious over Glaesel.

App. NO. 10/030,033

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

35 U.S.C. § 103 - Glaesel/Suess35 U.S.C. § 103 - Glaesel/Woertz

We now turn to the obviousness rejection, in which claims 9, 10, and 13 have been rejected as being obvious over a combination of Glaesel with Suess and claim 14 has been rejected as being obvious over a combination of Glaesel with Woertz under 35 U.S.C. § 103. We respectfully traverse.

For a discussion as to why Glaesel does not render the claimed invention obvious, please see the arguments above. On reviewing Suess and Woertz, we see that the secondary references do not make up for the shortcomings of the primary reference. That is the claims are non-obvious over the combinations quite in the same way as over the reference Glaesel alone.

In considering the prior art teachings of record in their totality, we should include the reference Köllmann in the discussion. Köllman discloses a base section, which abuts against both edge flanges of a U-shaped conductor bar. This part (insulator stops 5), however, is formed from plastic and is not integrally formed with the metallic contact clamps 6 or the spring bars 9. The reason for this is that Köllmann teaches a strict separation between the attachment of the

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

terminal clamp on the track on the one side and the electrical contacting and energy supply on the other side. To wit:

[A]chieves a clear separation of function. The insulator terminal case . . . fastening the series terminal . . . while the metal insert of the terminal . . . is responsible exclusively for the best possible electric contacting and power conduction.

Köllmann, col. 3, lines 12-24.

Should the person of skill in the art, while reading Glaesel, find Köllmann, he could for this reason not simply use the base section of Köllmann because it consists of plastic. Instead, he would have to make an inventive leap and recognize that the base section could, firstly, also be made of metal and, secondly, could in this case then be integrally formed with the locking and latching section. Glaesel, as noted above, teaches away from this idea because the connecting terminal according to Glaesel consists of an insulating material and in Köllman from an insulating and a conductive material.

The secondary reference Suess discloses a contact element 2, which is formed in one piece from a stamped metal sheet (a metal).

It follows that, in order to arrive at the claimed invention, the skilled artisan would have to consider Glaesel, then

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

modify the primary teaching with Köllmann, disregard the strict separation mentioned in Köllmann, and then utilize Sues in order to embody the conductor track connection in one piece, from a punch metal sheet. Only this three-way combination leads to a structure that resembles the invention, except, or course, for the locking contact projection 42.

Even after this (artificial and, indeed, capricious) combination of the three prior art references, the person of skill in the art would not have reached the claimed invention.

Only the additional feature, i.e., that the locking section has a locking section projection (42), in the combination, leads to a connecting terminal which is attached to the conductor in a more stable manner.

The connecting terminal is connected on the opposite ends of the edge flange and between these ends on the base section projections 20 with the conductor bar, which results in a more stable connection between the connecting terminal and the conductor bar.

More importantly, even, the claimed invention is not obvious for legal reasons, in that the Examiner has not made out a prima facie case of obviousness. It is well settled that

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

almost all claimed inventions are but novel combinations of old features. When "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant".

Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). As pointed out above, the reference not only lack the suggestion towards the combination, but they indeed teach away from the combination. Certainly, there is no "clear and

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

particular" teaching or suggestion in Suess or Wörtz to modify the primary reference Glaesel.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led towards the modification.

It is respectfully submitted that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application.

"It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps The references themselves must

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

In summary, none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 16. These claims are, therefore, patentable over the art and since all of the dependent claims are ultimately dependent thereon, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1 and 4-22 are solicited.

If an extension of time for this paper is required, petition for extension is herewith made.

No monies are due. However, please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

In the event the Examiner should still find any of the claims to be unpatentable, he is respectfully requested to telephone counsel so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is

Amdt. dated December 2, 2004

Reply to Office action of September 21, 2004

requested as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

Respectfully submitted,



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